

REMARKS

Applicants address the examiner's remarks in the order presented in the Office Action (dated August 18, 2009). All claim amendments are made without prejudice and do not represent acquiescence in any ground of rejection.

STATUS OF THE CLAIMS

Claims 1-26 were pending in the present application. Claims 13-25 have been canceled, having previously been withdrawn as directed to a non-elected invention. The claims have been amended without prejudice to pursuing the canceled subject matter in one or more related applications. Claims 1, 6, and 26 have been amended for clarity and consistency of claim language. Claims 27-37 are new. Following entry of the amendments, claims 1-12 and 27-37 will be pending and at issue. No new matter is added.

Support for the claim amendments can be found throughout the specification and in the claims as originally filed. Claim 6 is amended to correct an inadvertent typographical error. Support for the amendments to claims 1 and 26 can be found, *e.g.*, in original claim 15 and EXAMPLE 1. Support for new claim 27 can be found, *e.g.*, in original claim 13. Support for new claim 28 can be found, *e.g.*, in original claim 17. Support for new claim 29 can be found, *e.g.*, in original claim 18. Support for new claim 30 can be found, *e.g.*, in original claim 19. Support for new claims 31 and 32 can be found, *e.g.*, on page 4, paragraph [0009]. Support for new claims 33 and 34 can be found, *e.g.*, on page 12, paragraph [0041]. Support for new claims 35-37 can be found, *e.g.*, on page 8, paragraph [0029].

The amendments to the claims therefore add no new matter and entry is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103Rejections over Polansky in view of Glad

Claims 1-5 and 11 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky (U.S. Patent App. No. 2003/0068616) (“Polansky”) in view of Glad (U.S. Patent No. 6,156,550) (“Glad”). Applicants traverse this ground of rejection.

Three requirements must be met for a *prima facie* case of obviousness. First, the prior art references must teach all the limitations of the claims. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. Third, a reasonable expectation of success is required. The cited prior art references do not teach all of the elements of the applicants’ claims. Therefore, a *prima facie* case of obviousness has not been made.

The combination of Polansky and Glad does not teach all of the elements of claims 1-5 and 11. Amended claims 1-5 and 11 are directed to a method for isolating macromolecules comprising partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads. Polansky discloses that glass test tubes may be coated with a polyacrylamide substrate and that antibodies can be immobilized on a substrate. Polansky does not disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads. In fact, at no point does Polansky disclose coating the inner wall of a tube with beads. Glad does not overcome the deficiencies of Polansky. Glad discloses a method of modifying a polymer surface by swelling or dissolving the top layer of the polymer using a solvent and embedding particles in the surface. However, at no point does Glad disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads. In fact, at no point does Glad disclose coating the inner wall of a tube with beads. Because the combination of Polansky and Glad does not teach all of the claim limitations, the combination cannot render claims 1-5 or 11 obvious.

Rejection over Polansky in view of Glad and Orth

Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of Orth (U.S. Patent App. No. 2003/0153010) (“Orth”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. Orth does not overcome the deficiencies of Polansky and Glad. Orth is directed to a method of biomolecular photo-based patterning on silica glass tubes. However, at no point does Orth disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and Orth does not teach all of the claim limitations, the combination cannot render claim 6 obvious.

Rejection over Polansky in view of Glad and Stimpson

Claim 7 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of Stimpson (U.S. Patent No. 5,599,668) (“Stimpson”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. Stimpson does not overcome the deficiencies of Polansky and Glad. Stimpson is directed to a method of detecting light scattering from light scattering labels. However, at no point does Stimpson disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and Stimpson does not teach all of the claim limitations, the combination cannot render claim 7 obvious.

Rejections over Polansky in view of Glad and Zhang

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of Zhang (U.S. Patent App. No. 2003/0046717) (“Zhang”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. Zhang does not overcome the deficiencies of Polansky and Glad. Zhang is directed to isolated nucleic acids that encode HTPL. However, at no point does Zhang disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and Zhang does not teach all of the claim limitations, the combination cannot render claims 8 and 9 obvious.

Rejection over Polansky in view of Glad and Liu

Claim 10 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of Liu (U.S. Patent App. No. 2004/0014101) (“Liu”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. Liu does not overcome the deficiencies of Polansky and Glad. Liu is directed to methods for analyzing polymorphic nucleic acids using duplex separation and/or identification techniques. However, at no point does Liu disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and Liu does not teach all of the claim limitations, the combination cannot render claim 10 obvious.

Rejection over Polansky in view of Glad and LaMotte

Claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of LaMotte (U.S. Patent No. 5,296,347) (“LaMotte”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. LaMotte does not overcome the deficiencies of Polansky and Glad. LaMotte is directed to a bridge immunoassay. However, at no point does LaMotte disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and LaMotte does not teach all of the claim limitations, the combination cannot render claim 12 obvious.

Rejection over Polansky in view of Glad and Schall

Claim 26 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky in view of Glad and further in view of Schall (U.S. Patent No. 6,699,677) (“Schall”). Applicants traverse this ground of rejection.

As discussed above, neither Polansky nor Glad discloses coating a tube with a plurality of beads by partially melting the inner surface. Schall does not overcome the deficiencies of Polansky and Glad. Schall is directed to the analysis of tethered receptor ligand interactions. However, at no point does Schall disclose partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads as claimed in the instant application. Because the combination of Polansky, Glad, and Schall does not teach all of the claim limitations, the combination cannot render claim 26 obvious.

In conclusion, the cited references do not disclose all of the claim limitations. Accordingly, a *prima facie* case of obviousness has not been presented by the Office. Without acceding to the propriety of the rejection of pending claims 1-12 and 26 under 35 U.S.C. §103(a), applicants respectfully request reconsideration of the claims as amended.

DOCKET NO.: 26774-14267
Application No.: 10/767,251
Office Action Dated: August 18, 2009

PATENT

CONCLUSION

In view of the foregoing, the application is now in condition for allowance. The prompt issuance of a formal Notice of Allowance is therefore requested. If the examiner believes that a personal communication will expedite further prosecution of this application, the examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: November 16, 2009

/Melissa Harwood/

Melissa Harwood
Registration No. 60,229

Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Telephone: (206) 389-4550
Facsimile: (650) 938-5200